

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Masashi SATO et al.

Application No.: 09/770,196

Filed: January 29, 2001

For: OLEFIN-BASED RESIN COMPOSITION, METHOD OF MAKING IT AND
ELECTRICAL WIRE COVERED WITH IT

Group Art Unit: 1774

Examiner: C. THOMPSON

Docket No.: 106872

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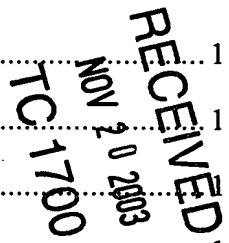
BRIEF ON APPEAL

Appeal from Group 1774

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I. INTRODUCTION

This is an appeal from an Office Action mailed June 3, 2003, rejecting claims 9-19 of the above-identified patent application. No claims are allowed. Although the June 3, 2003, Office Action is not a Final Rejection, the claims have been at least twice rejected, in the Office Actions mailed May 31, 2002, and November 20, 2002.

A. Real Party in Interest

The real parties in interest for this appeal and the present application are Sumitomo Wiring Systems, Ltd., and Sumitomo Electric Industries, Ltd., by way of Assignments recorded in the U.S. Patent and Trademark Office at Reel 11494, Frame 0222 and Reel 012780, Frame 0865.

B. Statement of Related Appeals and Interferences

There are presently no appeals or interferences, known to Appellant, Appellant's representative, or the Assignees, which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

C. Status of Claims

Claims 9-19 are pending. Claims 9-19 are on appeal. Claims 9-19 are set forth in the attached Appendix. Claims 9, 15, 18 and 19 are independent. Claims 10-14 and 16 directly or indirectly depend from claim 9; and claim 17 directly depends from claim 15.

D. Status of Amendments

A Supplemental Amendment was filed with a Request for Continued Examination on March 20, 2003. All requested amendments have been entered.

II. THE INVENTION

The claimed invention is directed to an electrical wire whose coating is a halogen-free resin composition containing metal hydroxide. Such an electrical wire is useful, for example, in a motor vehicle. Page 1, lines 5-8. The electrical wire coating composition provides a good balance of properties, such as, for example, wear resistance, flame resistance, tensile

property, flexibility and the like, which are required for the covering material of an electrical wire. Page 2, lines 17-21.

More specifically, the claimed invention is directed to an electrical wire comprising an electrically conductive core and a covering on said core, said covering being an olefin-based resin composition comprising a resin consisting essentially of the following resin components: (a) 39 - 94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight, (b) 1 - 20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride, (c) 5 - 60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride, wherein a total of the components (a), (b) and (c) is 100 parts by weight, and said olefin-based resin composition further comprising (d) 30 - 200 parts by weight of a metal hydroxide, based on 100 parts by weight of the resin components. Claim 9.

According to the claimed invention, the types and amounts of the respective components (a)-(d) are specifically selected and controlled to provide the desired beneficial properties to the coating composition. See, for example, specification at page 3, line 9 to page 5, line 2.

III. THE APPLIED REFERENCES

The applied references are:

- 1) U.S. Patent No. 4,722,959 to Inoue et al. ("Inoue"); and
- 2) European Patent Application No. 0273516 ("EP 516").

IV. ISSUES

The issue on appeal is whether claims 9-19 would have been obvious under 35 U.S.C. §103(a) over Inoue in view of EP 516.

V. GROUPING OF CLAIMS

Each claim of this patent application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. §282. However, for convenience in handling of this appeal, all of the claims will be grouped and argued together. Thus, pursuant to 37 C.F.R. §1.192(c)(7), in this Appeal, the rejected claims stand or fall together.

VI. ARGUMENT

The Examiner rejects claims 9-19 over Inoue in view of EP 516 under 35 U.S.C. §103(a). In the rejection, the Examiner has consistently improperly applied the law relating to obviousness, and has failed to establish even a prima facie case of obviousness. Proper application of the law demonstrates that no prima facie case of obviousness has been shown.

A. Factual Inquiries to Determine Obviousness/Non-Obviousness

Several basic factual inquiries must be made in order to determine obviousness or non-obviousness of claims of a patent application under 35 U.S.C. §103. These factual inquiries are set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966):

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined.

Graham goes on to state that:

Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

383 U.S. at 17-18, 148 USPQ at 467.

The specific factual inquiries set forth in Graham have not been considered or properly applied by the Examiner in formulating the rejection of the subject claims. Particularly, the

scope and content of the prior art and the level of ordinary skill in the pertinent art were not properly determined and demonstrated and applied to the claimed invention.

In the present case, proper consideration of the factual inquiries demonstrates nonobviousness of the claimed invention. The cited references do not teach or suggest the claimed electrical wires having an olefin-based resin covering composition.

B. The Claims Would Not Have Been Obvious Over the References

All of claims 9-19 are rejected under 35 U.S.C. §103(a) over Inoue in view of EP 516. The Examiner argues that it would have been obvious to modify the composition of Inoue using materials from EP 516, and thus to practice the claimed invention. Applicant respectfully traverses this rejection and requests that it be reversed and withdrawn.

Independent claim 9, representative of the claimed invention, is directed to an electrical wire comprising an electrically conductive core and a covering on said core, said covering being an olefin-based resin composition comprising a 100 parts by weight resin and 30-200 parts by weight of a metal hydroxide, based on 100 parts by weight of the resin components. The resin consists essentially of the following resin components: (a) 39 - 94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight, (b) 1 - 20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride, and (c) 5 - 60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride, wherein a total of the components (a), (b) and (c) is 100 parts by weight. Such a composition, and electric wiring including such a composition, is not taught or suggested by the cited references.

Furthermore, the Examiner has failed to set forth even a *prima facie* case of obviousness of the claimed invention. The requirements for a *prima facie* case of obviousness

are specified and described in MPEP §2143. According to MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. The reference applied in the Final Rejection fails to teach or suggest all the claim limitations, and there is no suggestion or motivation to modify the references.

1. Inoue Does Not Teach or Suggest the Claimed Invention

In contrast to the claimed invention, Inoue only discloses a flame-retardant olefin polymer composition comprising the following components (a), (b) and (c). 100 parts by weight of the resin component includes (a) 99 to 60% by weight of an ethylene-alpha-olefin copolymer having a density of 0.86 to 0.91 g/cm³, a boiling n-hexane insoluble matter of 10% by weight or more and a maximum peak temperature of 100°C or more in terms of differential scanning calorimeter and (b) 1 to 40% by weight of an olefin polymer modified with an unsaturated carboxylic acid or its derivative. Component (c) is 20 to 200 parts by weight of an inorganic flame retarder. Abstract. Inoue also discloses an electrical material employing the aforesaid composition. Abstract.

The Office Action incorrectly argues that Inoue discloses all of the limitations of the claimed invention, and that any differences between the claimed invention and Inoue would have been obvious to one of ordinary skill in the art. Inoue neither teaches nor suggests each of the separate elements of the claimed invention, or their combination.

a. Inoue Does Not Teach Component (a)

Component (a) in the composition of the claimed invention is 39-94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight. Inoue does not teach or suggest this component.

With respect to the component (a), Inoue does not disclose that the component is a propylene polymer selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight. At most, Inoue discloses that the material can be an ethylene-alpha-olefin copolymer. Col. 6, lines 40-60. The ethylene-alpha-olefin copolymer is further described to include 5-40 mol% alpha-olefin content. Col. 2, lines 40-41. Specific examples of the ethylene-alpha-olefin copolymer are stated to include an ethylene-propylene copolymer (having $MI=0.5$ g/10 min and density= 0.890 g/cm³) and ethylene-propylene copolymer (having $MI=1.9$ g/10 min and density= 0.86 g/cm³, trade name: EP02p; Japan Synthetic Rubber Co., Ltd.). Col. 11, lines 3-11.

However, nowhere does Inoue disclose that the propylene content is at least 50% by weight, as claimed. Because the propylene content can vary, it would not be inherent that Inoue's polymers would have such a high propylene content, particularly in view of the fact that Inoue discloses that all of the materials must include at least ethylene in addition to the alpha-olefin.

The Examiner acknowledges this deficiency of Inoue, but merely asserts that Applicants have not established criticality of the at least 50% limitation. See June 3, 2003, Office Action at page 4, lines 12-16. However, such a burden is not on Applicants in the first instance. Rather, the burden is initially on the Examiner to establish a prima facie case of obviousness of the claimed invention. In the instant case, the Examiner has nowhere shown why one of ordinary skill in the art would have been motivated to select propylene as the particular alpha-olefin component, and then diverge from the low content of Inoue (5-40 mol%) to the higher content of the claimed invention (at least 50 weight%). Because the Examiner has not shown why one of ordinary skill in the art would have selected the claimed

features from the disclosure of Inoue, Applicants are not required by law to demonstrate criticality of the claimed features.

Inoue nowhere teaches that the propylene content in the copolymer is important, or that any specific effects could or would be achieved by selecting the instantly claimed higher propylene content. Inoue thus fails to teach or suggest component (a) as claimed.

b. Inoue Does Not Teach Component (b)

Component (b) in the composition of the claimed invention is 1-20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride. Inoue also does not teach or suggest this component.

With respect to the component (b), Inoue does not disclose that the component is specifically polypropylene modified with 0.1 - 10% by weight of an acid anhydride, as claimed. At most, Inoue discloses that the described material (b) can be an olefin polymer modified with an unsaturated carboxylic acid or a derivative thereof. Col. 7, lines 10-16. Although Inoue broadly and separately discloses that the olefin polymer can be polypropylene, that the unsaturated carboxylic acid can be maleic acid, and that the derivative can be an anhydride, such separate disclosures would not have rendered obvious the claimed invention.

Nowhere does Inoue specifically teach or suggest the three separate choices of (1) selecting polypropylene from among the long list of disclosed polymers, (2) selecting maleic acid from among the long list of disclosed unsaturated carboxylic acids, and (3) selecting an anhydride of such maleic acid, and then using those materials to form the identified component. In fact, in the Examples, Inoue discloses as the component (b) only the use of ethylene-1-butene copolymers. Col. 11, lines 15-23.

In the June 3, 2003, Office Action, the Examiner correctly points out that Inoue discloses polypropylene and maleic acid to be suitable and/or preferred choices for materials.

However, those disclosures alone do not provide the motivation to modify Inoue to practice the claimed invention. For example, while Inoue discloses that polypropylene can be used (col. 7, lines 18-19), and in fact may be preferred (col. 7, line 29), Inoue actually goes on to state that "more preferably olefin polymers are an ethylene homopolymer ... and an ethylene-alpha-olefin copolymer and mixtures thereof." See col. 7, lines 31-34. Accordingly, one of ordinary skill in the art seeking to modify Inoue would not have been motivated to use polypropylene as the component (b), but instead would have been motivated to use an ethylene homopolymer, an ethylene-alpha-olefin copolymer, or a mixtures thereof, which Inoue specifically discloses to be the most preferred.

It is not sufficient that each element merely be disclosed in the reference. Rather, the reference must teach or suggest combining those separate components according to the claimed invention, in order to have rendered obvious the claimed invention. Inoue nowhere provides any such teachings, and thus at most teaches that all of the combinations would provide comparable results. Inoue fails to teach or suggest that specific selection of the monomer, acid anhydride, and modification amount would provide any improved results. Inoue thus fails to have rendered obvious component (b) of the claimed resin.

c. Inoue Does Not Teach Component (c)

Component (c) in the composition of the claimed invention is 5-60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride. Inoue also does not teach or suggest this component.

With respect to the component (c), Inoue does not teach or suggest that the component is specifically a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride, as claimed. At most, Inoue discloses that "the following rubbers may be used together with the above mentioned olefin polymers." Inoue then discloses that the rubbers include styrene-butadiene rubber. Col. 7, lines 35-39. However, Inoue does not teach or

suggest that the rubbers, much less the specific styrene-butadiene rubber, should be specifically modified in the same manner as the component (b). That is, Inoue does not teach or suggest that the rubber should likewise be modified with 0.1 - 10% by weight of an acid anhydride, as claimed. In fact, the Examples set forth in Inoue fail to teach or suggest the inclusion of a styrene-butadiene rubber at all, much less in the modified form required by the instant claims.

In response, the Examiner argues in the June 3, 2003, Office Action that Inoue discloses "that a styrene-butadiene rubber that can be used with a modified olefin wherein the preferred unsaturated carboxylic acid is maleic anhydride." See Office Action at page 5, lines 2-4. However, the passage to which the Examiner is referring, Inoue at col. 7, lines 7, lines 44-48, clearly does not relate to the use of components to modify the rubber materials. Rather, that passage refers back to the "copolymers of unsaturated carboxylic acids and unsaturated carboxylates" that Inoue describes as suitable components (b). Thus, Inoue nowhere teaches or suggests that even the discloses rubber compounds can be modified, as required in the claimed invention.

Furthermore, Inoue only teaches, at most, that the rubber materials, such as styrene-butadiene rubber, can be used "together with" the olefin polymers. However, that disclosure only refers at most to a mixture of the rubber material with the olefin polymer, i.e., a mixture of two separate components. Inoue does not disclose, teach or suggest that the rubber material and the olefin polymers should be combined in a single component, i.e., as a styrene-based polymeric elastomer, as claimed. Inoue then further does not teach or suggest that such a unitary component should be further modified with 0.1 - 10% by weight of an acid anhydride, as described above.

Inoue thus not only fails to teach or suggest the basic material of the claimed component (c) itself, but fails to teach or suggest the further modification of that component. Accordingly, in total, Inoue fails to have rendered obvious the claimed invention.

d. Inoue Does Not Teach the Claimed Combination

As described above, Inoue fails to teach or suggest each of the required components (a), (b), and (c) of the claimed invention. Because Inoue does not teach or suggest the claimed components by themselves, Inoue likewise cannot teach or suggest combining those separate components together into a resin, as claimed. The Examiner has failed to set forth even a prima facie case of obviousness, and Inoue thus fails to have rendered obvious the claimed invention

2. EP 516 Does Not Overcome the Deficiencies of Inoue

The Examiner admits that Inoue does not disclose all of the claim limitations. However, the Examiner cites EP 516, and argues that EP 516 discloses the missing claimed elements, and that it would have been obvious to combine EP 516 with Inoue to practice the claimed invention. Applicants disagree.

EP 516 discloses a flame retardant insulation composition comprising a functionalized selectively hydrogenated monoalkenyl arene-conjugated diene block copolymer, a plasticizer, polypropylene, and a hydrated inorganic filler. Abstract. The Examiner further points out that EP 516 discloses that the polypropylene can be maleic anhydride functionalized polypropylene. Page 4, lines 30-33.

However, EP 516 suffers from many of the same deficiencies as Inoue. Although EP 516 discloses that the polypropylene can be maleic anhydride functionalized polypropylene, the reference fails to teach or suggest that the polypropylene is specifically modified with 0.1 - 10% by weight of an acid anhydride, as claimed. EP 516 instead merely discloses that

various commercially available maleic anhydride functionalized polypropylenes can be used, such as that sold as Plexar 2110 by Northern Petrochemical Company.

Accordingly, even the combination of EP 516 with Inoue fails to teach or suggest the specific component (b) of the claimed invention. The combination of references fails to disclose the specific functionalization amount, which is an express limitation of the claimed invention. Nor does EP 516 teach or suggest the specific combination of the particular materials (a), (b) and (c) required in the claimed invention.

The claims are thus patentable over the cited combination of references.

3. There is No Motivation to Combine the Cited References

Further, even if EP 516 taught the elements missing from Inoue, which it does not, there is no motivation to combine the cited references in the first instance to practice the claimed invention. The Examiner asserts that the references are combinable because it is known in the art that EP 516's hydrogenated monoalkenyl arene-conjugated diene block copolymers are known to provide specific advantages. Whether or not this is true, Applicants' disagree with the conclusion reached by the Examiner.

In the first instance, regardless of any known benefits that may be provided by the copolymers of EP 516, such benefits have nothing to do with the omissions of Inoue. The Examiner cites EP 516 as disclosing the maleic acid functionalization of polypropylene, but this feature is separate from the hydrogenated monoalkenyl arene-conjugated diene block copolymer component of EP 516. Even if the copolymers of EP 516 are known to provide better results, such knowledge would not have motivated one of ordinary skill in the art to have looked at the reference's separate disclosure of using maleic acid functionalized polypropylene.

In the second instance, even if the copolymers of EP 516 are known to be superior, then the Examiner has failed to establish any motivation to combine EP 516 and Inoue. If EP

516 indeed were superior, then one of ordinary skill in the art would simply have been motivated to use the coating composition disclosed in EP 516 itself, rather than to attempt to modify the composition of Inoue. Any other reason for combining the references would merely be an improper hindsight reconstruction of the claimed invention, which is improper.

Thus, despite the teachings of EP 516, EP 516 still fails to teach or suggest the above-described omissions of Inoue. Furthermore, EP 516 fails to provide any teaching or suggestion to modify its disclosed compositions, and then to incorporate such modified teachings into the disclosed compositions of Inoue.

4. Conclusion

For at least these reasons, any combination of Inoue and EP 516 fails to have rendered obvious the claimed invention. Independent claim 9, and claims 10-14 dependent therefrom, as well as claims 15, 18 and 19, would not have been obvious to one of ordinary skill in the art over the cited references.

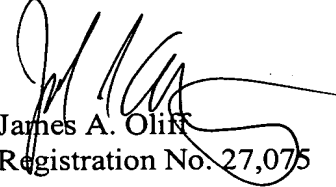
C. Conclusion

Accordingly, because Inoue fails to teach or suggest all of the limitations of the claimed invention, and because such deficiencies are not addressed in EP 516, the claimed invention defines patentable subject matter over the cited references.

VII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that all of claims 9-19 define patentable subject matter under 35 U.S.C. §103(a) over the cited references, and are in thus condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejection of claims 9-19.

Respectfully submitted,



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APPENDIX

CLAIMS:

9. An electrical wire comprising an electrically conductive core and a covering on said core, said covering being an olefin-based resin composition comprising a resin consisting essentially of the following resin components:

(a) 39 - 94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight,

(b) 1 - 20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride,

(c) 5 - 60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride

wherein a total of the components (a), (b) and (c) is 100 parts by weight,

and said olefin-based resin composition further comprising

(d) 30 - 200 parts by weight of a metal hydroxide, based on 100 parts by weight of the resin components.

10. An electrical wire according to claim 9, wherein the amount of component (b) is 5 - 20 parts by weight, the amount of component (c) is 5 - 50 parts by weight, and the amount of component (d) is 50 - 150 parts by weight.

11. An electrical wire according to claim 9, wherein the acid anhydride in components (b) and (c) is maleic acid anhydride.

12. An electrical wire according to claim 9, wherein said metal hydroxide is magnesium hydroxide surface-treated with a silane coupling agent selected from the group consisting of an aminosilane coupling agent, a vinylsilane coupling agent and an epoxysilane coupling agent.

13. An electrical wire according to claim 9, wherein a resin content of said composition consists essentially of said resin components (a)-(c).

14. An electrical wire according to claim 9, wherein a resin content of said composition consists of said resin components (a)-(c).

15. An electrical wire comprising an electrically conductive core and a covering on said core, said covering being an olefin-based resin composition comprising the following resin components:

(a) 39 - 94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight,

(b) 1 - 20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride,

(c) 5 - 60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride,

wherein a total of the components (a), (b) and (c) is 100 parts by weight and no other resin component is present in the composition,

and said olefin-based resin composition further comprising

(d) 30 - 200 parts by weight of a metal hydroxide, based on 100 parts by weight of the resin components.

16. An electrical wire according to claim 9, wherein said olefin-based resin composition is halogen-free.

17. An electrical wire according to claim 15, wherein said olefin-based resin composition is halogen-free.

18. An electrical wire comprising an electrically conductive core and a covering on said core, said covering being an olefin-based resin composition consisting essentially of the following resin components:

(a) 39 - 94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight,

(b) 1 - 20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride,

(c) 5 - 60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride,

wherein a total of the components (a), (b) and (c) is 100 parts by weight,

and said olefin-based resin composition further comprising

(d) 30 - 200 parts by weight of a metal hydroxide, based on 100 parts by weight of the resin components.

19. An electrical wire comprising an electrically conductive core and a covering on said core, said covering being an olefin-based resin composition consisting of the following resin components:

(a) 39 - 94 parts by weight of a propylene polymer having a melt flow rate of 0.1 - 5 g/10 min. and selected from propylene homopolymers and propylene-ethylene copolymers having a propylene content of at least 50% by weight,

(b) 1 - 20 parts by weight of a polypropylene modified with 0.1 - 10% by weight of an acid anhydride,

(c) 5 - 60 parts by weight of a styrene-based polymeric elastomer modified with 0.1 - 10% by weight of an acid anhydride,

wherein a total of the components (a), (b) and (c) is 100 parts by weight,

and said olefin-based resin composition further comprising

(d) 30 - 200 parts by weight of a metal hydroxide, based on 100 parts by weight of the resin components.